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BRIAN M BERLINER, ESQ O'MELVENY & MYERS, LLP 400 SOUTH HOPE STREET LOS ANGELES, CA 90071-2899				
EXAMINER CARLSON, JEFFREY D				
ART UNIT		PAPER NUMBER		
3622				

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/755,541

Applicant(s)

ROTHSCHILD, ANTHONY R.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities:

The disclosure contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. Applicant should delete the URLs/email links on page 10 line 26, page 13 line 17, page 16 line 4.

Appropriate correction is required.

### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities:

- Claim 1 line 15, "additional advertisement" should be replaced by --additional communication data--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 9-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claims describe features where the sender provides the additional communication data. This is apparently described on page 16 lines 19-29 to page 17 line 7, however the features and how to accomplish such are not clear to the examiner. It is not clear what a "populated communication page" is, nor how it is used to provide the described effects such as extraction of recipient and advertisement by the application.

Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear how the application can identify the recipient device for the original incoming personal communication and advertisement.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 49-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 49 line 7, there is no antecedent basis for "said additional communication data."

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanbach, Jr. et al (US6449657) in view of KR99073076A (application published 10-5-1999; WO 00/58882 is part of the patent family and is being used as a translation) and Camut et al (US6684257).

Regarding claims 1, 18, 19, 25, 31, 42, 49, Stanbach, Jr. et al teaches an email server which selects advertisements and inserts them (attaches or embeds) into personal communication messages composed by a sender [col 9]. A demographic profile provided by the sender determines the selected/inserted ad; this can be said to be "selection" by the sender as the sender is responsible for the profile-based selection. However, KR99073076A also teaches an email system where ads are inserted into emails. KR99073076A teaches that the sender can select the ad to be included from a selection of plural ads [pg 3 lines 4-8, pg 6 lines 11-13]. It would have been obvious to one of ordinary skill at the time of the invention to have enabled the sending user to select the ad to be included as taught by KR99073076A, so that the sender can control and define the highly targeted ads. Stanbach, Jr. et al teaches that the ads may include URLs or HTML inserted into the message body and may link the recipient to more

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information upon activation/interaction [14:43-47]. It would have been obvious to one of ordinary skill at the time of the invention to have stored and provided the additional requested data on the email host as a matter of design choice so that the host can provide the requesting recipient with the additional data. Camut et al teaches that it is well known for requesting Internet browser clients to have special data format needs. Camut et al teaches that it is well known to identify the requesting browser/client/hardware, transcode the requested data into a preferable format and deliver it to the requesting client for rendering [2:28-43, 3:1-30]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such transcoding services with the ad email service so that PDA, cell phone, etc recipients of the email ads can request and properly render the additional information.

Regarding claims 5, 6, 52, KR99073076A teaches that the email address of the server may be used to redirect the mail. Further, Stanbach, Jr. et al teaches deletion of the senders email by the system [pg 11:4-16].

Regarding claims 7, 8, 33, 34, 50, 51, it would have been obvious to one of ordinary skill at the time of the invention to have presented the sender with the ad categories in order to organize the possible selections. KR99073076A teaches that the user's selections can be stored by the system [10:1-3]. Further, Official Notice is taken that it is known to identify selections made by a user as "recently used" or "favorites." it would have been obvious to one of ordinary skill at the time of the invention to have defined a user-pallet of ads for selection, using the user's previous selections so that a

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“favorites” list is created and can be used for future selections without requiring the user to review all possible selections.

As best understood regarding claims 9-12, 16, 17, 21, 48, 57-59, it would have been obvious to one of ordinary skill at the time of the invention to have received additional data directly from any party including the email service, sender, advertiser or other 3<sup>rd</sup> party regarding the additional communication data. The system inherently extracts its data from storage; any of the provided data can be taken to be “advertisement” data or additional communication data. The system as proposed inherently generates a personal communications (email).

Regarding claims 13-15, 35-37, 53, 61, KR99073076A teaches compensation for senders and recipients upon sending and viewing the additional ad information. It would have been obvious to one of ordinary skill at the time of the invention to have compensated any of the parties for any of the steps of sending ads, viewing ads, requesting more ad info and making purchases, so as to encourage maximum advertising and commerce.

Regarding claims 20-22, a “staff” member tasked with programming, running, maintaining, backing up, troubleshooting, (etc...) the system of Stanbach, Jr. et al is taken to inherently have access to the stored data. Stanbach, Jr. et al teaches that served ads can be tracked and stored so that advertisers can receive feedback regarding the advertising [14:60-62]. Stanbach, Jr. et al teaches that the ad insertions are tracked using ad identifiers [14:50-52, 13:5-7]. It would have been obvious to one of ordinary skill at the time of the invention to have granted 3<sup>rd</sup> party advertisers secure

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access to the system so that they can provide advertising information and extract advertising usage data/reports from the system in a manner as is well known.

Regarding claims 26-30, 43, 44, 54, Camut et al teaches mobile clients (PDAs, Internet capable phones, etc) that can receive Internet web page data. It would have been obvious to one of ordinary skill at the time of the invention for both senders and receivers to be using such devices and to access the email application server for convenience. It would have been obvious to one of ordinary skill at the time of the invention to have downloaded any necessary plug-in or client software from the application system as required to the "pervasive" wireless mobile devices of Camut et al, so that mobile users can create, submit, send and receive emails using the system wirelessly. Regarding claim 30, connecting the mobile client to the email system is taken to inherently provide "compiled" identifying the client and the selected ad when the user accesses the system to choose an ad for delivery.

Regarding claim 32, Stanbach, Jr. et al teaches that the ads can be selected randomly [13:14-16].

Regarding claims 38-40, KR99073076A provides a means for preventing fraud [11:18-24] whereby compensation to the sender is limited. It would have been obvious to one of ordinary skill at the time of the invention to have limited the sender's compensation in any way including by limiting the number of times (including a single time) a recipient can be used for delivering an ad, in order to prevent spamming and revenue generation with sending numerous emails to recipients.



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7. Claims 2-4, 41, 45-47, 55, 56, are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanbach, Jr. et al in view of KR99073076A and Camut et al further in view of Bayeh et al (US6012098). Bayeh et al teaches that XML and XSL style sheets can be used to provide requested information as a device and data neutral format, separating the content of the data from its possible display formatting. It would have been obvious to one of ordinary skill at the time of the invention to have used XML with the email ad system so that requested additional data by the recipients can be retrieved and formatted for a variety of platforms and devices. The steps of retrieving and formatting the requested information is inherently separate from the output/delivery stage (which uses TCP/IP).

8. Claims 23, 24, 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanbach, Jr. et al, KR99073076A and Camut et al in view of Rakavy et al (US6317789). Stanbach, Jr. et al teaches that he ads may be in various formats, including multimedia [20:59-61]. Rakavy et al teaches an online ad system whereby multimedia ad files are sent to the client along with the required players to render the ads [12:30-48]. It would have been obvious to one of ordinary skill at the time of the invention to have sent the ad data (first portion) and the required plug-ins/players/client viewers as needed (second portion).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc